

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JENS STEFAN SCHNEIDER, FRANK STANGLMEIER,
and BERND SCHUMANN

Appeal No. 2004-1856
Application No. 09/908,413

ON BRIEF

Before GARRIS, WARREN, and OWENS, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-4 which are all of the claims remaining in the application.

The subject matter on appeal relates to a coated structure. With reference to the appellants' drawing, the structure comprises a ceramic substrate 11, an electrically conductive base coat 13, a porous overcoat 15 and at least one additional layer

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21, 22, 23 formed in pores of the porous overcoat in direct contact with the base coat. This appealed subject matter is adequately represented by independent claim 1:

1. A coated structure, comprising:
 - a ceramic substrate;
 - an electrically conductive base coat arranged on the ceramic substrate;
 - a porous overcoat arranged over the base coat; and
 - at least one additional layer formed in pores of the porous overcoat in direct contact with the base coat.

The reference set forth below is relied upon by the examiner in the Section 102 rejection before us:

Kurachi et al. (Kurachi)	4,863,583	Sep. 5, 1989
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Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kurachi.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

For the reasons which follow, we cannot sustain this rejection.

The examiner finds the additional layer defined by appealed independent claim 1 to be anticipated by the catalytic layer of Kurachi (e.g., see figure 2). According to the appellants, this finding is in error because patentee's catalytic layer is not "formed in pores of the porous overcoat" and is not "in direct contact with the base coat" as required by the appealed claims. On page 4 of the answer, the examiner responds to the appellants' argument in the following manner:

Appellant argues that the Examiner has not pointed to a teaching of at least one additional layer formed in pores of the porous overcoat in direct contact with the base coat. The Examiner points to the teaching at col. 3, lines 1-5 which clearly discloses an additional layer of a catalytic coating may be applied either by deposition or impregnated into the porous overcoat and this catalytic layer is formed of the same metals as recited in instant claim 4 shown at col. 6, lines 3-7, lines 56-60, and col. 9, lines 30-35. Kurachi discloses a catalyst applied to the protective overcoat by impregnation, which would mean the overcoat has pores, which would ultimately produce an additional catalytic layer formed within those pores.

As correctly pointed out by the appellants, the column 3 disclosure referred to by the examiner relates to a discussion by Kurachi, not of his invention but rather, of the invention described in prior art U.S. Patent Number 4,199,425 (see lines 65-68 in column 2 in conjunction with lines 1-5 in column 3 which were cited by the examiner). Nowhere does Kurachi describe the catalytic layer of his invention as formed by impregnating his

porous overcoat (i.e., to thereby yield a "layer formed in pores of the porous overcoat in direct contact with the base coat" as required by the independent claim on appeal). Instead, patentee's catalytic layer is disclosed as spaced from (rather than in direct contact with) his measuring electrode (i.e., electrically conductive base coat) via a porous spacer layer and is disclosed as being printed on this porous spacer layer (rather than formed in pores of the porous overcoat as here claimed). In this latter regard, see the paragraph bridging columns 8 and 9, lines 30-44 in column 9 and example 3 of the Kurachi patent.

Under the circumstances recounted above, it is apparent that the examiner, in reaching her finding of anticipation, has selectively picked Kurachi's disclosure of a prior art invention in the paragraph bridging columns 2 and 3 and combined it with patentee's figure 2 disclosure of his own invention. This is inappropriate. For this Section 102 rejection to be proper, the Kurachi patent must clearly and unequivocally disclose the here claimed coated structure or direct those skilled in the art to this coated structure without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the patent. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). As earlier

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explained, Kurachi's column 3 disclosure concerning a prior art invention is not at all related to the subsequent disclosure concerning his invention.

For these reasons, the examiner's anticipation finding is erroneous. It follows that we cannot sustain the Section 102 rejection of claims 1-4 as being anticipated by Kurachi.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

BRG:hh

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